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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/014,103	12/11/2001	Alex Mashinsky	5106-5	2650

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COHEN, PONTANI, LIEBERMAN & PAVANE  
551 Fifth Avenue, Suite 1210  
New York, NY 10176

EXAMINER
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BORLINGHAUS, JASON M

ART UNIT	PAPER NUMBER
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3693

DATE MAILED: 08/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	10/014,103	MASHINSKY ET AL.	
	Examiner	Art Unit	
	Jason M. Borlinghaus	3693	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 05 June 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 February 2001 and 12 April 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>3/13/06</u>   | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

**Claims 4, 7, 11 and 14** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1 – 2 reference “media content” while Claim 4 claims “the content media”, while Claim 7 references both “media content” and “the content media”. Examiner is unable to ascertain whether these terms merely suffer from a lack of antecedent basis, evidence of typographical error or just confusing terminology.

Similar problems exist between Claims 9 – 11 and between Claims 12 – 14.

Claim 3 claims “a buyer’s content database” and “a seller’s content database” and Claim 4 claims “a contents database connected to the switching node.” Claim 4 further claims “the contents database.” Examiner is unable to ascertain to which database the phrase “the contents database” is referencing, as there is no descriptive identifier attached to the phrase. Furthermore, examiner is unable to ascertain whether “a contents database connected to the switching node” is a third, as yet unclaimed, database or one of the originally claimed two databases as “a buyer’s content database” and “a seller’s content database”, as claimed in Claim 3, are also connected to the “switching node.”

Claim 7, lines 4 – 6, claims “means for delivering the content media from the buyer to the offer media content of the seller of the matched pair at the switching node.” (emphasis added). Examiner is unable to ascertain exactly what the applicant is claiming due to a possible typographical error. Examiner assumes that the applicant seeks to claim “means for delivering content media from the buyer to the seller of the matched pair at the switching node.” Examiner will apply prior art based upon this assumption.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

**Claims 1 –14** are rejected under 35 U.S.C. 103(a) as being unpatentable over Eldering (US Patent 6,324,519).

**Regarding Claims 1 – 8**, Eldering discloses a system for trading media space, comprising:

- a server node (consumer profile server) operatively connectable to user interfaces for receiving requests for media space (advertising space/opportunities) from buyers (advertisers) and offers of media space (advertising space/opportunities) from sellers (content providers), said server node (consumer profile server) comprising a set of rules (correlation operation) for matching (correlating) one of the requests and one of the offers to form a matched request and offer pair and for generating a signal (transmission) indicating formation of the matched request and offer (correlation result). (see abstract; fig. 1 and 7; col. 9, line 32 – col. 12, line 26);
- a delivery system (network) connected to said server node (consumer profile server) for facilitating delivery of media content (advertisement) between the buyer (advertiser) and seller (content provider) of the matched (correlated) request and offer pair in response to a signal (correlation result) from said server node (consumer profile server) and such that said delivery (transmission) is performed externally to said server node. (consumer profile server). (see abstract; fig. 1 and 7; col. 9, line 32 – col. 12, line 26);
- means for sending (transmitting) notice of the matched request and offer pair (correlation result) to said delivery system (network), and wherein said

delivery system (network) comprises means for sending the media content (advertisement) of the one of the buyers (advertisers) of the matched pair to the one of the sellers (content providers) of the matched (correlated) pair in response to the notice (correlation result). (see abstract; fig. 1 and 7; col. 9, line 32 – col. 12, line 26);

- wherein said delivery system (network) comprises a connection between said server node (customer profile server), a buyer's content database (ad server) and a seller's content database (content server), wherein the media content (advertisement) is delivered from the buyer's content database (ad server) to the seller's content database (content server) via said connection. (see abstract; fig. 1 and 7; col. 9, line 32 – col. 12, line 26);
- wherein said delivery system further comprises a contents database (ad server) connected to a means for receiving (network) and storing the content media (ad characterization) from the buyer (advertiser) when the request (request for advertising space/opportunities) is submitted to the server node (customer profile server) and storing the content media information (ad characterization) in the contents database (customer profile server), and means for delivering the content media (advertisement) from the contents database (ad server) to the one of the sellers (content providers) of the matched (correlated) pair via the

connection (network). (see abstract; fig. 1 and 7; col. 9, line 32 – col. 12, line 26);

- wherein said connection to said buyer's content database (ad server) and said seller's content database (content server) via a file transfer means (transport protocols). (see abstract; fig. 1 and 7; col. 9, line 32 – col. 12, line 26);
- wherein said connection to said buyer content database (ad server) and said seller content database (content server) via a file transfer means (transport protocols) consisting of one of an IP network (Internet) and e-mail system (e-mail messages). (see abstract; fig. 1 and 7; col. 9, line 32 – col. 12, line 26);
- wherein said delivery system (network) further comprises a contents database (web site) connected to means for receiving and storing the offered media content (listing of advertising opportunities) from the seller (content provider) when the offer (advertising space/opportunities) submitted to the server node (web site) and storing the offered media content (listing of advertising opportunities) in the contents database (web site), and means for delivering (Internet) the content media (advertisement) from the buyer (advertiser) to the seller (content provider) of the matched (correlated) pair; and

- wherein said server node (customer profile server) is connectable to the buyers and the sellers via a wide area communication network (Internet).  
(see abstract; fig. 1 and 7; col. 9, line 32 – col. 12, line 26).

Eldering does not teach underlined claim limitations - a system for trading media space comprising:

- a switching node.

Utilization of a switching node is old and well known in the art of information technology and telecommunications. It would have been obvious to one of ordinary skill in the art to have modified Eldering by incorporating such components, devices and/or technologies that were conventional and/or standard in the art of information technology and telecommunications at the time the invention was made.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified Eldering to combine disparate databases into one database, since it has been held that forming in one piece an article which has formerly been formed in two pieces and put together involves only routine skill in the art. *Howard v. Detroit Stove Works*, 150 U.S. 164 (1893); *In re Larson, Russler & Meldahl*, 340 F.2d 965, 967, 144 USPQ 347, 349 (CCPA 1965).

Additionally, the concept of central delivery, receipt, storage and/or transmission of information between multiple parties through a central hub, such as a centralized database, is old and well known in the art. It would have been obvious to one of ordinary skill in the art to have modified Eldering by incorporating the processing and/or storage of information on a central database, as is old and well known in the art, to



capture the benefits of utilizing conventional and/or standard information technology topographies.

**Regarding Claims 9 - 14**, Claims 9 - 14 recite similar limitations and/or would have been obvious based upon Claims 1 - 8 rejected above, and are therefore rejected using the same art and rationale as applied in the rejection of Claims 1 - 8.

As for additional and/or differing claim limitations, Eldering does not teach that the methodologies, protocols and/or practices are automatic. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have automated the method, since it has been held that broadly providing a mechanical or automatic means to replace manual activity that accomplishes the same result involves only routine skill in the art. *In re Venner*, 120 USPQ 192.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason M. Borlinghaus whose telephone number is (571) 272-6924. The examiner can normally be reached on 8:30am-5:00pm M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on (571) 272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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ELLA COLBERT  
PRIMARY EXAMINER

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